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DUANE MORRIS LLP			COZART, JERMIE E	
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118
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/695,205
Filing Date: October 28, 2003
Appellant(s): RICHARD ET AL.

MAILED
JUN 22 2007
GROUP 3700

Gary R. Maze
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/11/07 appealing from the Office action mailed 9/14/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The advisory action mailed 11/16/06 was incorrect in that the advisory action listed claims 5 and 9 as being objected when in fact claims 5 and 9 should have been listed as being rejected. The pre-appeal decision mailed 1/23/07 correctly listed claims 5 and 9 as being rejected and not objected to as previously indicated in the advisory action mailed 11/16/06.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 5 and 9 have been added to

the grounds for rejection under 35 U.S.C. 102(b) as being anticipated by Echols (US 6,941,652 B2).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,941,652 ECHOLS ET AL. 09-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Echols et al. (US 6,941,652 B2).

Echols discloses manufacturing a screen (40) for down-hole use by inserting a base pipe (38) into a cylindrically shaped filter layer (40), securing the filter layer (40) to the base pipe (38) by expanding (col. 5, lines 1-4) the base pipe (38). An interference fit is created between the base pipe and filter layer by expansion (col. 5, lines 1-4) of the base pipe. The size of the filter layer (40) is reduced (i.e. compressed). Since the filter layer (40) is secured to the base pipe (38) by expansion, it is clearly apparent that the filter is secured to the base pipe without welding (i.e. only shroud/protective layer 42 is secured by welding not the filter (40); col. 6, lines 38-40), adhesives or mechanical connectors. The base pipe (38) and filter layer (40) are inserted down-hole, and the base pipe (38) is expanded down-hole. A projective jacket (42) is mounted over the

Art Unit: 3726

filter layer (40) before inserting the base pipe (38). See column 3, line 27 – column 6, line 56, and figures 1A-7 for further clarification.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echols et al. (US 6,941,652 B2).

Echols discloses expanding the base pipe, however, Echols does not expressly disclose expanding the base pipe for at least a portion of the length of the filter layer, expanding the base pipe near the ends of the filter layer, or expanding the base pipe for the entire length of the filter layer and beyond.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to expand the base pipe for at least a portion of the length of the filter layer, to expand the base pipe near the ends of the filter layer, and to expand the base pipe for the entire length of the filter layer and beyond because Applicant has not disclosed that expanding the base pipe for at least a portion of the length of the filter layer, expanding the base pipe near the ends of the filter layer, or expanding the base pipe for the entire length of the filter layer and beyond provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the expanding of the base pipe as taught by Echols because the screen is secured to the base pipe by expansion.

Therefore, it would have been an obvious matter of design choice to modify Echols to obtain the invention as specified in claims 12-14.

(10) Response to Argument

Appellants state that Echols teaches away from the claimed method of assembling a screen assembly by failing to recognize that expansion of the base pipe is a technique to attach a screen layer to it. Appellants further state that Echols attaches the screen to the base pipe by welding. Appellants also state that the expansion of the base pipe occurs down-hole.

In response, the Examiner maintains that Echols teaches inserting a base pipe (38) into a filter layer (40), and securing the filter layer (40) to the base pipe (38) by expanding the base pipe (38). Echols (col. 5, lines 1-4) states that "when the base pipe 38 is expanded radially outwardly, the filter media (40) will be radially compressed between the shroud 42 and base pipe 38." This radial compression is clearly a result of the radial expansion of the base pipe (38) and therefore since the filter (40) is compressed between the base pipe (38) and shroud (42) then for all intents and purposes the filter is thereby secured to the base pipe (38). Echols states that the shroud/protective jacket (42) is attached to the base pipe (38) by welding (col. 6, lines 38-40), however, Echols is silent as to if the filter layer is secured to the base pipe (38) by welding. The only acknowledgement of contact between the base pipe (38) and filter (40) is through the radial expansion (col. 5, lines 1-4) of the base pipe (38) which in turn radially compresses the filter (40) thereby securing the filter to the base pipe between the base pipe and shroud/protective jacket (42). The Examiner acknowledges that the expansion of the base pipe occurs down-hole, however, claim 1 does not preclude the expansion from occurring down-hole.

Appellants state that Claim 1 is about the initial fabrication of the screen assembly. Appellants state that the Examiner jumps around the Echols reference giving it a meaning that is not there by virtue of his confusion between the disclosed Echols method of running the finished product and the Echols method of fabrication of the underlying product.

In response, the Examiner maintains that claim 1 is broad, and the body of the claim merely requires "inserting a base pipe into a filter layer; securing said filter layer to said base pipe by expanding said base pipe" which have been anticipated by Echols as explained in detail above. In addition, the Examiner maintains that since the body is able to stand alone, therefore it is irrelevant as to whether or not the Appellants interpretation of Echols differs from that of the Examiner when Echols clearly teaches the limitations contained in the body of the claims. Finally a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the case of the present invention, the process steps of claims 1, 2, 4-7, 9, and 12-14 are able to stand alone and thereby have been anticipated under 35 U.S.C. 102(b) by the teachings of Echols.

Art Unit: 3726

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Conferees:



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